ESTTA Tracking number:

ESTTA486498 07/31/2012

Filing date:

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

# **Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

# **Opposer Information**

Name	BHPC ASSOCIATES LLC
Granted to Date of previous extension	09/05/2012
Address	1370 Broadway New York, NY 10018 UNITED STATES

Attorney information	Robert L. Epstein Epstein Drangel LLP 60 East 42nd Street, Suite 2410 New York, NY 10165 UNITED STATES
	mail@ipcounselors.com Phone:212-292-5390

# Applicant Information

Application No	85224666	Publication date	05/08/2012
Opposition Filing Date	07/31/2012	Opposition Period Ends	09/05/2012
International Registration No.	NONE	International Registration Date	NONE
Applicant	Royal County of Berkshire Polo Club Ltd. North Street Winkfield Windsor Berkshire, SL44TH UNITED KINGDOM		

# Goods/Services Affected by Opposition

#### Class 009.

All goods and services in the class are opposed, namely: Spectacles, spectacle cases, spectacle frames, spectacle glasses, sunglasses; and accessories therefor, namely, chains for spectacles and sunglasses, cases for spectacles and sunglasses, and lenses for spectacles and sunglasses; and tape rulers

#### Class 014.

All goods and services in the class are opposed, namely: Watches, clocks, jewellery, precious stones, precious metals, goods coated with precious metals, namely, cuff links, desktop model figures, figurines, goblets, jewellery boxes, key chains, key rings, medals, rings, trinkets and trophies

#### Class 018.

All goods and services in the class are opposed, namely: Leather goods and imitation leather goods, namely, leather and imitation leather bags, briefcases, credit card holders, key cases, leashes for animals, attaché cases, carrying cases and credit card cases, briefcase-type portfolios, purses, suitcases, wallets, sports bags, traveling bags and straps therefor, luggage; athletic bags, shopping bags made of skin, beach bags, cosmetic bags sold empty, diaper bags, duffel bags, garment bags

for travel, gym bags, make-up bags sold empty, overnight bags, school bags, school book bags, shoulder bags, suit bags, tote bags, travel bags, bags for umbrellas; trunks, holdalls, handbags, wallets, purses, briefcases, suitcases, rucksacks, carry-all bags, carry-on bags; umbrellas, parasols, walking sticks; whips, harnesses and saddlery

#### Class 025.

All goods and services in the class are opposed, namely: Clothing, footwear and headgear, namely, T-shirts, sleepwear, shirts, hats, shorts, sweat bands, sweat pants, sweat shirts, sweat shorts, sweat suits, socks and sweaters, belts, jeans, pants, skirts, underwear, jackets, coats, swimwear, leather shoes, canvas shoes, sneakers, slippers, boots, flip flops, caps and hats

# **Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)	
Torres v. Cantine Torresella S.r.l.Fraud	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)	

# Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1429311	Application Date	11/12/1985
Registration Date	02/17/1987	Foreign Priority Date	NONE
Word Mark	BEVERLY HILLS POLO CLU	В	
Design Mark	POLO CLUB		
Description of Mark	NONE		
Goods/Services  Class 025. First use: First Use: 1985/02/18 First  CLOTHING FOR MEN, WOMEN AND CHILDRE SWEATSHIRTS, SWEAT SUITS, SWEATERS, UNDERWEAR, CAPS, JACKETS, [LEOTARDS,		IEN AND CHILDREN ITS, SWEATERS, T-	-NAMELY SHIRTS, SHIRTS, PANTS,

U.S. Registration No.	1751058	Application Date	10/01/1991
Registration Date	02/09/1993	Foreign Priority Date	NONE
Word Mark	BEVERLY HILLS POLO CLUB		

Design Mark	POLO CLUB	
Description of Mark	NONE	
Goods/Services	Class 009. First use: First Use: 1991/05/31 First Use In Commerce: 1991/05/31	
	ophthalmic eyewear; namely, eyeglass frames, lenses, chains, and cases; eyeglasses; and sunglasses	
	Class 014. First use: First Use: 1991/08/31 First Use In Commerce: 1991/08/31 watches	
	Class 018. First use: First Use: 1991/03/31 First Use In Commerce: 1991/03/31	
	wallets, umbrellas, and small leather goods; namely, credit card cases, key cases, and coin purses	
	Class 024. First use: First Use: 1991/03/01 First Use In Commerce: 1991/03/01	
	beach towels, bath towels, table linens and textile placemats, and bed and bath accessories; namely, fabric toilet seat covers	
	Class 025. First use: First Use: 1989/10/31 First Use In Commerce: 1989/10/31	
	clothing for men, women and children; namely, shirts, sweatshirts, sweaters, tee shirts, pants, caps, hats, jackets, dresses, socks, hosiery, raincoats and outerwear; namely, coats and jackets, and belts	

U.S. Registration No.	2181220	Application Date	09/09/1996
Registration Date	08/11/1998	Foreign Priority Date	NONE
Word Mark	BEVERLY HILLS POLO CLU	В	
Design Mark	POLO CLUB		
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use luggage	e: 1997/07/15 First U	lse In Commerce: 1997/07/15

U.S. Registration	2214846	Application Date	08/08/1994
No.			

Registration Date	12/29/1998	Foreign Priority Date	NONE
Word Mark	BEVERLY HILLS POLO CLU	В	
Design Mark	POLO CLUB		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use	e: 1994/10/01 First Us	se In Commerce: 1994/10/01
	footwear, namely shoes, boot	s, slippers, athletic sh	noes, and golf shoes

Attachments	73568042#TMSN.gif ( 1 page )( bytes ) 74209022#TMSN.gif ( 1 page )( bytes )
	74203022#TMSN.gif ( 1 page )( bytes ) 75162739#TMSN.gif ( 1 page )( bytes ) 74558586#TMSN.gif ( 1 page )( bytes )
	073112 Notice of Opposition.pdf ( 34 pages )(1112706 bytes )

# **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/robert I. epstein/
Name	Robert L. Epstein
Date	07/31/2012

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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## **NOTICE OF OPPOSITION**

Opposer, BHPC Associates LLC, of 1370 Broadway, New York City, New York 10018, believes that it would be damaged by the issuance of a registration in International Class 009, International Class 014, International Class 018 and International Class 025 based upon Application Serial No. 85224666, filed January 24, 2011, for the trademark ROYAL COUNTY OF BERKSHIRE POLO CLUB and Polo Player Design and therefore opposes said application.

As grounds for its Notice of Opposition, Opposer, by and through its undersigned attorneys, alleges as follows:

1. Continuously and long prior to the filing date of January 24, 2011 of Application Serial No. 85224666, Opposer has offered and continues to offer a variety of goods, including ophthalmic eyewear, watches, wallets, luggage, bags, small leather goods and clothing bearing the mark BEVERLY HILLS POLO CLUB and a design including the image of a polo player on

horseback swinging his mallet (the "BEVERLY HILLS POLO CLUB and Polo Player Design mark").

- 2. Over a prolonged period of time, Opposer has invested a substantial amount of time, effort and money promoting its BEVERLY HILLS POLO CLUB and Polo Player Design mark and the goods bearing that mark. As a result of its promotional efforts, a tremendous volume of sales, and extensive use of the BEVERLY HILLS POLO CLUB and Polo Player Design mark, Opposer's BEVERLY HILLS POLO CLUB and Polo Player Design mark has attained widespread acclaim in the United States, and has come to be exclusively recognized as identifying the products of Opposer. Since long before any use of or alleged rights of Applicant in the mark hereby opposed, Opposer's BEVERLY HILLS POLO CLUB and Polo Player Design mark has become distinctive of Opposer's goods and represents a tremendous amount of goodwill of Opposer's business.
- 3. In addition to its common law rights, Opposer owns the following incontestable United States trademark registrations of the BEVERLY HILLS POLO CLUB and the Polo Player Design mark for use in the aggregate in connection with Opposer's goods:

MARK	Class(es)	REGISTRATION NUMBER	REGISTRATION DATE
POLO CHIB	25	1429311	02-17-1987

POLO CLUB	09,14,18,24,25	1751058	02-09-1993
POLO CLUB	18	2181220	08-11-1998
POLO CLUB	25	2214846	12-29-1998

- 4. Opposer's registrations are valid, subsisting, in full force and effect, incontestable, and are evidence of Opposer's exclusive rights to use its registered marks on the identified goods, pursuant to 15 U.S.C. §§ 1057 and 1115.
- 5. Upon information and belief, Royal County of Berkshire Polo Club Ltd. ("Applicant") filed with the United States Patent and Trademark Office Application Ser. No. 85224666, on January 24, 2011, based in part on intent to use the trademark ROYAL COUNTY OF BERKSHIRE POLO CLUB and Polo Player Design for the following goods:

"Spectacles, spectacle cases, spectacle frames, spectacle glasses, sunglasses; and accessories therefore" in International Class 009;

"Watches, jewellery, precious stones, precious metals, goods coated in precious metals goods coated with precious metals" in International class 014;

"Leather Goods, imitation leather goods; trunks, travel bags, umbrellas, parasols, whips, harnesses, saddler, walking sticks" in International Class 018; and

"Articles of clothing, footwear and headgear" in International Class 025.

- 6. Upon information and belief, said Application Ser. No. 85224666 was allowed and published by the United States Patent and Trademark Office on May 8, 2012, the application which Opposer opposes herein.
- 7. Applicant is not connected to Opposer in any way and has not been authorized by Opposer to use the mark of Application Serial No. 8522466 in International Classes 009, 014, 018, and 025.

#### **COUNT I: Priority and Likelihood of Confusion**

- 8. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 7 as if fully set forth herein.
  - 9. Upon information and belief, Opposer acquired rights in the BEVERLY HILLS

POLO CLUB and Polo Player Design mark prior to any date on which Applicant can rely in connection with the mark of Application Serial No. 85224666.

- 10. Opposer's BEVERLY HILLS POLO CLUB and Polo Player Design mark is the same as or similar to the mark of Application Serial No. 85224666 in appearance, sound, meaning and commercial impression, both marks including the word POLO and confusingly similar polo player images, arranged in a similar manner, with the confusingly similar polo player images situated above the word POLO.
- 11. The goods of the respective parties in International Classes 009, 014, 018, and 025 are identical or commercially related, and/or the conditions and activities surrounding the marketing of same are such that they would or could be encountered by the same persons under circumstances that could give rise to the mistaken belief that they originate from the same source.
- 12. As a result, the mark of Application Serial No. 85224666, when used in connection with the goods in International Classes 009, 014, 018, and 025 identified said application, is likely to cause confusion or mistake or to deceive and mislead the trade and the purchasing public into believing that Applicant's goods are the goods of Opposer, or that Applicant or its goods are authorized, licensed or controlled by Opposer, or that Applicant is affiliated with or in some way related to Opposer. Accordingly, any such use or/and registration of the mark of Application Serial No. 85224666 in International Classes 009, 014, 018, and 025 would and does violate Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).
- 13. By reason of the foregoing, Opposer will be damaged by the registration of the mark of Application Serial No. 85224666 in International Classes 009, 014, 018, and 025.

#### **COUNT II: Fraud**

- 14. Opposer repeats and realleges each of the allegations set forth in Paragraphs 1 through 13 of the Notice of Opposition above, as though same were fully set forth herein.
- 16. Application Serial No. 85224666 contained a representation that applicant has a bona fide intention to use Applicant's mark in commerce with the goods and/or services identified in the application with respect to International Class 009; in International Class 014; in International Class 018; in International Class 025. A copy of said application is annexed hereto as **Exhibit A**.
- 17. On October 18, 201, Applicant's attorney filed a Response to Office Action which amended the identification of goods in International Class 009, International Class 014, International Class 018 and International Class 025 and stated: "Applicant confirms that it intends to rely both on its intent-to-use in or with the United States under Section 1(b)..."

A copy of that Response to Office Action, without attachments, is annexed hereto as Exhibit B.

18. The representations as to Applicant's bona fide intent to use Applicant's in commerce the use with the goods in International Class 009, International Class 014, International Class 018 and International Class 025 as forth in Application Serial No. 85224666 of Exhibit A, and in the Response to Office Action of Exhibit B were each submitted on behalf of Applicant to induce the USPTO issue allow Application Serial No. 85224666, were relied upon by the USPTO in allowing Application Serial No. 85224666, and the USPTO would not have allowed Application Serial No. 85224666 without same. Accordingly, said representations as to Applicant's bona fide intent to use of the mark in commerce on the goods in International

Class 009, International Class 014, International Class 018 and International Class 025 submitted by or on behalf of Applicant were material to the allowance of Application Serial No. 85224666.

- 19. Upon information and belief, as of January 24, 2011, the date of filing of Application Serial No. 85224666, Applicant did not have a bona fide intent to use Applicant's Mark in commerce on or in connection with some or all of the goods or services identified in International Class 009, International Class 014, International Class 018 and International Class 025 of Application Serial No. 85224666.
- 20. Upon information and belief, as of October 18, 2011, the date Applicant's attorney filed the Response to Office Action confirming Applicant's bona fide intent to use the mark on the good and services in International Class 009, International Class 014, International Class 018 and International Class 025 of Application Serial No. 85224666, as amended, Applicant did not have a bona fide intent to use Applicant's Mark in commerce on or in connection with some or all of the goods or services identified in International Class 009, International Class 014, International Class 018 and International Class 025 of Application Serial No. 85224666, as amended.
- 21. Upon information and belief, the representations contained in Application Serial No. 85224666 as to Applicant's bona fide intention to use Applicant's Mark in commerce on the goods or services identified in International Class 009, International Class 014, International Class 018 and International Class 025 of Application Serial No. 85224666, as originally filed, were false.
- 22. Upon information and belief, the representations contained in the Response to Office Action filed October 18, 2011 as to Applicant's bona fide intention to use Applicant's Mark in commerce on the goods or services identified in International Class 009, International Class 014, International Class 018 and International Class 025 of Application Serial No.

85224666, as amended, were false.

- 23. Upon information and belief, the representations as to Applicant's bona fide intention to use Applicant's Mark in commerce on the goods or services identified in International Class 009, International Class 014, International Class 018 and International Class 025 of Application Serial No. 85224666, as originally filed, were made by or on behalf of Applicant with knowledge of the falsity thereof.
- 24. Upon information and belief, the representations as to Applicant's bona fide intention to use Applicant's Mark in commerce on the goods or services identified in International Class 009, International Class 014, International Class 018 and International Class 025 of Application Serial No. 85224666, as amended, were made by or on behalf of Applicant with knowledge of the falsity thereof.
- 25. Upon information and belief, the representations as to Applicant's bona fide intention to use Applicant's Mark in commerce on the goods or services identified in International Class 009, International Class 014, International Class 018 and International Class 025 of Application Serial No. 85224666, as originally filed, were made by or on behalf of Applicant with a reckless disregard for the truth or validity thereof.
- 26. Upon information and belief, the representations as to Applicant's bona fide intention to use Applicant's Mark in commerce on the goods or services identified in International Class 009, International Class 014, International Class 018 and International Class 025 of Application Serial No. 85224666, as amended, were made by or on behalf of Applicant with a reckless disregard for the truth or validity thereof.
- 27. Upon information and belief, the representations as to Applicant's bona fide intention to use Applicant's Mark in commerce on the goods or services identified in International Class 009, International Class 014, International Class 018 and International Class

025 of Application Serial No.85224666 were made by or on behalf of Applicant with intent to

deceive the USPTO into allowing Application Serial No. 8522466, when it otherwise would not

have been allowed.

28. Upon information and belief, the allowance of Application Serial No. 85224666

was obtained by fraud.

Dated: July 31, 2012

29. By reason of the foregoing, Petitioner will be damaged by the issuance of a

registration of the mark of Application Serial No. 85224666.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the

Application Serial No. 8522466 not be allowed to issue into a registration for goods in

International Class 009, International Class 014, International Class 018 and International Class

025 of Application Serial No. 85224666, as amended.

Respectfully submitted,

EPSTEIN, DRANGEL LLI

Ву: 📙

Robert L. Epstein

William C. Wright Jason M. Drangel

60 East 42<sup>nd</sup> Street, Suite 2410

New York, New York 10165

Tel. No.: (212) 292-5390

Fax. No.: (212) 292-5391

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# **EXHIBIT A**

# Trademark/Service Mark Application, Principal Register

**Serial Number: 85224666 Filing Date: 01/24/2011** 

# The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85224666
MARK INFORMATION	
*MARK	\\TICRS\EXPORT11\IMAGEOUT 11\852\246\85224666\xml1\ APP0002.JPG
SPECIAL FORM	YES
USPTO-GENERATED IMAGE	NO NO
LITERAL ELEMENT	ROYAL COUNTY OF BERKSHIRE POLO CLUB
COLOR MARK	NO
*DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of the words ROYAL COUNTY OF BERKSHIRE POLO CLUB with the depiction of a horse with a rider holding a polo stick/mallet.
PIXEL COUNT ACCEPTABLE	YES
PIXEL COUNT	595 x 842
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Royal County of Berkshire Polo Club Ltd.
*STREET	North Street Winkfield Windsor
*CITY	Berkshire
*COUNTRY	United Kingdom
*ZIP/POSTAL CODE (Required for U.S. applicants only)	SL44TH
LEGAL ENTITY INFORMATION	
ТҮРЕ	corporation

GOODS AND/OR SERVICES AND BASI	S INFORMATION
INTERNATIONAL CLASS	009
*IDENTIFICATION	Spectacles, Spectacle Cases, Spectacle Frames, Spectacle Glasses, Sun Glasses; and Accessories Therefore
FILING BASIS	SECTION 1(b)
FILING BASIS	SECTION 44(e)
FOREIGN REGISTRATION NUMBER	2106096
FOREIGN REGISTRATION COUNTRY	United Kingdom
FOREIGN REGISTRATION DATE	02/02/2001
FOREIGN REGISTRATION EXPIRATION DATE	07/24/2016
DATE FOREIGN REGISTRATION RENEWED (if applicable)	06/09/2006
INTERNATIONAL CLASS	014
*IDENTIFICATION	Watches, Jewellery, Precious Stones, Precious Metals, Goods Coated in Precious Metals
FILING BASIS	SECTION 1(b)
FILING BASIS	SECTION 44(e)
FOREIGN REGISTRATION NUMBER	2278406
FOREIGN REGISTRATION COUNTRY	United Kingdom
FOREIGN REGISTRATION DATE	06/14/2002
FOREIGN REGISTRATION EXPIRATION DATE	08/20/2011
INTERNATIONAL CLASS	016
*IDENTIFICATION	Pens, Pencils, Writing and Drawing Instruments, Stationery, Notepaper, Writing Paper, Gift Wrapping Paper, Envelopes, Greeting Cards, Post Cards, Magazines, Books, Playing Cards, Rulers, Painting Sets, Posters, Calendars, Diaries, Photograph

	Albums, Stickers, Labels, Sketch Pads, Paper Party Decorations, Paper Napkins, Pen and Pencil Cases, Facial Tissues
FILING BASIS	SECTION 1(b)
FILING BASIS	SECTION 44(e)
FOREIGN REGISTRATION NUMBER	2106096
FOREIGN REGISTRATION COUNTRY	United Kingdom
FOREIGN REGISTRATION DATE	02/02/2001
FOREIGN REGISTRATION EXPIRATION DATE	07/24/2016
DATE FOREIGN REGISTRATION RENEWED (if applicable)	06/09/2006
INTERNATIONAL CLASS	018
*IDENTIFICATION	Leather Goods; Imitation Leather Goods; Trunks, Travel Bags, Umbrellas, Parasols, Whips, Harnesses, Saddlery, Walking Sticks
FILING BASIS	SECTION 1(b)
FILING BASIS	SECTION 44(e)
FOREIGN REGISTRATION NUMBER	2106096
FOREIGN REGISTRATION COUNTRY	United Kingdom
FOREIGN REGISTRATION DATE	02/02/2001
FOREIGN REGISTRATION EXPIRATION DATE	07/24/2016
DATE FOREIGN REGISTRATION RENEWED (if applicable)	06/09/2006
INTERNATIONAL CLASS	025
*IDENTIFICATION	Articles of Clothing, Footwear and Headgear
FILING BASIS	SECTION 1(b)
FILING BASIS	SECTION 44(e)
FOREIGN REGISTRATION NUMBER	1402908

COUNTRY	United Kingdom
FOREIGN REGISTRATION DATE	08/11/1995
FOREIGN REGISTRATION EXPIRATION DATE	10/25/2016
DATE FOREIGN REGISTRATION RENEWED (if applicable)	09/15/2006
ATTORNEY INFORMATION	
NAME	Mark G. Kachigian
ATTORNEY DOCKET NUMBER	BAI525-1019/11015
FIRM NAME	Head, Johnson & Kachigian, P.C.
STREET	228 West 17th Place
CITY	Tulsa
STATE	Oklahoma
COUNTRY	United States
ZIP/POSTAL CODE	74119
PHONE	918-587-2000
FAX	918-584-1718
EMAIL ADDRESS	mkachigian@hjklaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Shawn M. Dellegar, Cassandra L. Wilkinson, Steven R. Tollette
CORRESPONDENCE INFORMATION	
NAME	Mark G. Kachigian
FIRM NAME	Head, Johnson & Kachigian, P.C.
STREET	228 West 17th Place
CITY	Tulsa
STATE	Oklahoma
COUNTRY	United States
ZIP/POSTAL CODE	74119
PHONE	918-587-2000
FAX:	918-584-1718

EMAIL ADDRESS	mkachigian@hjklaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	5
FEE PER CLASS	325
*TOTAL FEE DUE	1625
*TOTAL FEE PAID	1625
SIGNATURE INFORMATION	
SIGNATURE	/markgkachigian/
SIGNATORY'S NAME	Mark G. Kachigian
SIGNATORY'S POSITION	Attorney of Record, an Oklahoma Bar member
DATE SIGNED	01/24/2011

## Trademark/Service Mark Application, Principal Register

**Serial Number: 85224666 Filing Date: 01/24/2011** 

#### To the Commissioner for Trademarks:

MARK: ROYAL COUNTY OF BERKSHIRE POLO CLUB (stylized and/or with design, see mark)

The literal element of the mark consists of ROYAL COUNTY OF BERKSHIRE POLO CLUB. The applicant is not claiming color as a feature of the mark. The mark consists of the words ROYAL COUNTY OF BERKSHIRE POLO CLUB with the depiction of a horse with a rider holding a polo stick/mallet.

The applicant, Royal County of Berkshire Polo Club Ltd., a corporation of United Kingdom, having an address of

North Street Winkfield Windsor

Berkshire SL44TH

United Kingdom

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 009: Spectacles, Spectacle Cases, Spectacle Frames, Spectacle Glasses, Sun Glasses; and Accessories Therefore

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of United Kingdom registration number 2106096, registered 02/02/2001 with a renewal date of 06/09/2006 and an expiration date of 07/24/2016, and translation thereof, if appropriate. 15 U. S.C. Section 1126(e), as amended.

International Class 014: Watches, Jewellery, Precious Stones, Precious Metals, Goods Coated in Precious Metals

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of United Kingdom registration number 2278406, registered 06/14/2002 with a renewal date of \_\_\_\_\_\_ and an expiration date of 08/20/2011, and translation thereof, if appropriate. 15 U. S.C. Section 1126(e), as amended.

International Class 016: Pens, Pencils, Writing and Drawing Instruments, Stationery, Notepaper, Writing Paper, Gift Wrapping Paper, Envelopes, Greeting Cards, Post Cards, Magazines, Books, Playing Cards, Rulers, Painting Sets, Posters, Calendars, Diaries, Photograph Albums, Stickers, Labels, Sketch

Pads, Paper Party Decorations, Paper Napkins, Pen and Pencil Cases, Facial Tissues Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15

U.S.C. Section 1051(b)).

Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of United Kingdom registration number 2106096, registered 02/02/2001 with a renewal date of 06/09/2006 and an expiration date of 07/24/2016, and translation thereof, if appropriate. 15 U. S.C. Section 1126(e), as amended.

International Class 018: Leather Goods; Imitation Leather Goods; Trunks, Travel Bags, Umbrellas, Parasols, Whips, Harnesses, Saddlery, Walking Sticks

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of United Kingdom registration number 2106096, registered 02/02/2001 with a renewal date of 06/09/2006 and an expiration date of 07/24/2016, and translation thereof, if appropriate 15 U. S.C. Section 1126(e), as amended.

International Class 025: Articles of Clothing, Footwear and Headgear

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of United Kingdom registration number 1402908, registered 08/11/1995 with a renewal date of 09/15/2006 and an expiration date of 10/25/2016, and translation thereof, if appropriate. 15 U. S.C. Section 1126(e), as amended.

The applicant's current Attorney Information:

Mark G. Kachigian and Shawn M. Dellegar, Cassandra L. Wilkinson, Steven R. Tollette of Head, Johnson & Kachigian, P.C.

228 West 17th Place Tulsa, Oklahoma 74119

**United States** 

The attorney docket/reference number is BAI525-1019/11015.

The applicant's current Correspondence Information:

Mark G. Kachigian
Head, Johnson & Kachigian, P.C.
228 West 17th Place
Tulsa, Oklahoma 74119
918-587-2000(phone)
918-584-1718(fax)
mkachigian@hjklaw.com (authorized)

A fee payment in the amount of \$1625 has been submitted with the application, representing payment for

#### Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /markgkachigian/ Date Signed: 01/24/2011

Signatory's Name: Mark G. Kachigian

Signatory's Position: Attorney of Record, an Oklahoma Bar member

RAM Sale Number: 3294

RAM Accounting Date: 01/25/2011

Serial Number: 85224666

Internet Transmission Date: Mon Jan 24 16:30:44 EST 2011 TEAS Stamp: USPTO/BAS-64.207.227.18-2011012416304452

6687-85224666-480c0e9f6567f16c8fda68dec4 b471b01-DA-3294-20110124153119861078



Royal County of Berkshire
POIN CLUB

# **EXHIBIT B**

# **Response to Office Action**

# The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85224666
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION (no change)	
ARGUMENT(S)	

This is in response to the Office Action e-mailed on April 24, 2011.

The Applicant gratefully acknowledges the Examining Attorney's finding that there are no similar registered or pending marks which would bar registration.

The Examining Attorney has requested clarification of the identification of goods. The Applicant appreciates the Examining Attorney's suggestion, and respectfully requests that the description of goods and services covered by the Applicant's mark be amended to read as follows:

Spectacles, spectacle cases, spectacle frames, spectacle glasses, sun glasses; and accessories therefore, namely, chains for spectacles and sunglasses, holders for spectacles and sunglasses, and lenses for spectacles and sunglasses in International Class 9; Watches, clocks, jewellery, precious stones, precious metals, goods coated with precious metals, namely, ashtrays, badges, blazer buttons, cigar and cigarette boxes, buckles for clothing, candlesticks, cosmetic powder compacts, cuff links, desktop ornaments, figurines, goblets, jewellery boxes, key chains, key rings, medals, perfume flasks, perfume sprayers, picture frames, rings, trinkets and trophies in International Class 14; Pens, pencils, writing instruments, drawing instruments, stationery, note paper, writing paper, gift wrapping paper, envelopes, greeting cards, post cards, magazines, books featuring stories and pictures, drawing rulers, tape rulers, painting sets for children; painting sets for artists, posters, calendars, diaries, photograph albums, stickers, shipping labels, printing labels, paper labels, sketch pads, paper party decorations, paper napkins, pen and pencil cases, facial tissue in International Class 16; Leather goods and imitation leather goods, namely, leather and imitation leather bags, briefcases, credit card holders, key cases, leashes for animals, cases, portfolios, purses, travelling suitcases, wallets, sports bags, straps and travelling bags; articles of luggage; athletic bags, shopping bags made of skin, beach bags, cosmetic bags sold empty, diaper bags, duffel bags, garment bags for travel, gym bags, makeup bags sold empty, overnight bags, school bags, school book bags, shoulder bags, suit bags, tote bags, travel bags and umbrella bags; trunks, holdalls, handbags, wallets, purses, briefcases, suitcases, rucksacks, carry all bags and carry-on bags; umbrellas, parasols and walking sticks; whips, harnesses and saddlery in International Class

18; and Clothing, footwear and headgear, namely, T-shirts, sleep wear, shirts, hats, shorts, sweat bands, sweat pants, sweat shirts, sweat shorts, sweat suits, socks and sweaters, belts, jeans, pants, skirts, underwear, jackets, coats, swimwear, shoes of leather or canvas, sneakers, slippers, boots, flip flops, caps and hats in International Class 25.

The Applicant believes that this amended description serves to clarify and limit, rather than expand upon, the present identification. Further, it is believed that the identification of goods is sufficiently specific to allow the Examining Attorney or third parties to reach judgment regarding possible conflicts. Lastly, it is clear, accurate and concise, as required under TMEP § 804.01.

The Examining Attorney has also requested that Applicant disclaim the wording "ROYAL COUNTY OF BERKSHIRE" apart from the mark as shown. The Applicant, in conformity with Trademark Act Section 6, 15 U.S.C. § 1056, and TMEP §§ 1213 and 1213.08(a), respectfully submits the following disclaimer of the wording "ROYAL COUNTY OF BERKSHIRE" in its application, to read as follows:

No claim is made to the exclusive right to use "ROYAL COUNTY OF BERKSHIRE" apart from the mark as shown.

Please amend the description of the mark to read:

"The mark consists of the words ROYAL COUNTY OF BERKSHIRE POLO CLUB below the design of a horse with rider holding a polo mallet."

Applicant is the owner of U.S. Trademark Registration Nos. 2,525,322; 3,378,599; and 3,740,106.

Finally, Applicant confirms that it intends to rely both on its intent-to-use in or with the United States under Section 1(b) and on the international registration under Section 44(e). A copy of the United Kingdom registrations will be provided as soon as possible.

Having addressed the concerns of the Examining Attorney, the Applicant respectfully requests that the refusal to register be withdrawn and that the mark be approved for publication in the *Official Gazette*. If any issues remain, a telephone conference with the Examining Attorney is respectfully requested.

# GOODS AND/OR SERVICES SECTION (009)(current) INTERNATIONAL CLASS 009 DESCRIPTION Spectacles, Spectacle Cases, Spectacle Frames, Spectacle Glasses, Sun Glasses; and Accessories Therefore FILING BASIS Section 1(b) FILING BASIS Section 44(e)

FOREIGN REGISTRATION NUMBER	2106096	
FOREIGN REGISTRATION COUNTRY	United Kingdom	
FOREIGN REGISTRATION DATE	02/02/2001	
FOREIGN EXPIRATION DATE	07/24/2016	
GOODS AND/OR SERVICES SECTION	ON (009)(proposed)	
INTERNATIONAL CLASS	009	
TRACKED TEXT DESCRIPTION		
	mes, spectacle glasses, sun glasses; and Accessories Therefore; s for spectacles and sunglasses, holders for spectacles and sunglasses	
FINAL DESCRIPTION		
	mes, spectacle glasses, sun glasses; and accessories therefore, sses, holders for spectacles and sunglasses, and lenses for	
FILING BASIS	Section 1(b)	
FILING BASIS	Section 44(e)	
FOREIGN REGISTRATION NUMBER	2106096	
FOREIGN REGISTRATION COUNTRY	United Kingdom	
FOREIGN REGISTRATION DATE	02/02/2001	
FOREIGN EXPIRATION DATE	07/24/2016	
GOODS AND/OR SERVICES SECTION	ON (014)(current)	
INTERNATIONAL CLASS	014	
DESCRIPTION		
Watches, Jewellery, Precious Stones, Pre	cious Metals, Goods Coated in Precious Metals	
FILING BASIS	Section 1(b)	
FILING BASIS	Section 44(e)	
FOREIGN REGISTRATION NUMBER	2278406	
FOREIGN REGISTRATION COUNTRY	United Kingdom	
FOREIGN REGISTRATION DATE	06/14/2002	
FOREIGN EXPIRATION DATE	08/20/2011	

## GOODS AND/OR SERVICES SECTION (014)(proposed)

INTERNATIONAL CLASS

014

#### TRACKED TEXT DESCRIPTION

Watches, Jewellery, Precious Stones, Precious Metals, Goods Coated in Precious Metals; Watches, clocks, jewellery, precious stones, precious metals, goods coated with precious metals, namely, ashtrays, badges, blazer buttons, cigar and cigarette boxes, buckles for clothing, candlesticks, cosmetic powder compacts, cuff links, desktop ornaments, figurines, goblets, jewellery boxes, key chains, key rings, medals, perfume flasks, perfume sprayers, picture frames, rings, trinkets and trophies

#### FINAL DESCRIPTION

Watches, clocks, jewellery, precious stones, precious metals, goods coated with precious metals, namely, ashtrays, badges, blazer buttons, cigar and cigarette boxes, buckles for clothing, candlesticks, cosmetic powder compacts, cuff links, desktop ornaments, figurines, goblets, jewellery boxes, key chains, key rings, medals, perfume flasks, perfume sprayers, picture frames, rings, trinkets and trophies

FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
FOREIGN REGISTRATION NUMBER	2278406
FOREIGN REGISTRATION COUNTRY	United Kingdom
FOREIGN REGISTRATION DATE	06/14/2002
FOREIGN EXPIRATION DATE	08/20/2011

#### GOODS AND/OR SERVICES SECTION (016)(current)

INTERNATIONAL CLASS

016

#### DESCRIPTION

Pens, Pencils, Writing and Drawing Instruments, Stationery, Notepaper, Writing Paper, Gift Wrapping Paper, Envelopes, Greeting Cards, Post Cards, Magazines, Books, Playing Cards, Rulers, Painting Sets, Posters, Calendars, Diaries, Photograph Albums, Stickers, Labels, Sketch Pads, Paper Party Decorations, Paper Napkins, Pen and Pencil Cases, Facial Tissues

FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
FOREIGN REGISTRATION NUMBER	1402908
FOREIGN REGISTRATION COUNTRY	United Kingdom
FOREIGN REGISTRATION DATE	08/11/1995
FOREIGN EXPIRATION DATE	10/25/2016

# GOODS AND/OR SERVICES SECTION (016)(proposed) 016 INTERNATIONAL CLASS TRACKED TEXT DESCRIPTION Pens, Pencils, Writing and Drawing Instruments, Stationery, Notepaper, Writing Paper, Gift Wrapping Paper, Envelopes, Greeting Cards, Post Cards, Magazines, Books, Playing Cards, Rulers, Painting Sets, Posters, Calendars, Diaries, Photograph Albums, Stickers, Labels, Sketch Pads, Paper Party Decorations, Paper Napkins, Pen and Pencil Cases, Facial Tissues; Pens, pencils, writing instruments, drawing instruments, stationery, note paper, writing paper, gift wrapping paper, envelopes, greeting cards, post cards, magazines, books featuring stories and pictures, drawing rulers, tape rulers, painting sets for children; painting sets for artists, posters, calendars, diaries, photograph albums, stickers, shipping labels, printing labels, paper labels, sketch pads, paper party decorations, paper napkins, pen and pencil cases, facial tissue FINAL DESCRIPTION Pens, pencils, writing instruments, drawing instruments, stationery, note paper, writing paper, gift wrapping paper, envelopes, greeting cards, post cards, magazines, books featuring stories and pictures, drawing rulers, tape rulers, painting sets for children; painting sets for artists, posters, calendars, diaries, photograph albums, stickers, shipping labels, printing labels, paper labels, sketch pads, paper party decorations, paper napkins, pen and pencil cases, facial tissue

FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
FOREIGN REGISTRATION NUMBER	1402908
FOREIGN REGISTRATION COUNTRY	United Kingdom
FOREIGN REGISTRATION DATE	08/11/1995
FOREIGN EXPIRATION DATE	10/25/2016
GOODS AND/OR SERVICES SECTION	ON (018)(current)
INTERNATIONAL CLASS	018
DESCRIPTION	
Leather Goods; Imitation Leather Goods; Saddlery, Walking Sticks	Trunks, Travel Bags, Umbrellas, Parasols, Whips, Harnesses,
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
GOODS AND/OR SERVICES SECTION	ON (018)(proposed)
INTERNATIONAL CLASS	018
TRACKED TEXT DESCRIPTION	

Leather Goods: Leather goods and imitation leather goods, namely, leather and imitation leather bags,

briefcases, credit card holders, key cases, leashes for animals, cases, portfolios, purses, travelling suitcases, wallets, sports bags, straps and travelling bags; Imitation Leather Goods; articles of luggage; Trunks, Travel Bags, Umbrellas, Parasols, Whips, Harnesses, Saddlery, Walking Sticks; athletic bags, shopping bags made of skin, beach bags, cosmetic bags sold empty, diaper bags, duffel bags, garment bags for travel, gym bags, makeup bags sold empty, overnight bags, school bags, school book bags, shoulder bags, suit bags, tote bags, travel bags and umbrella bags; trunks, holdalls, handbags, wallets, purses, briefcases, suitcases, rucksacks, carry all bags and carry-on bags; umbrellas, parasols and walking sticks; whips, harnesses and saddlery

#### FINAL DESCRIPTION

Leather goods and imitation leather goods, namely, leather and imitation leather bags, briefcases, credit card holders, key cases, leashes for animals, cases, portfolios, purses, travelling suitcases, wallets, sports bags, straps and travelling bags; articles of luggage; athletic bags, shopping bags made of skin, beach bags, cosmetic bags sold empty, diaper bags, duffel bags, garment bags for travel, gym bags, makeup bags sold empty, overnight bags, school bags, school book bags, shoulder bags, suit bags, tote bags, travel bags and umbrella bags; trunks, holdalls, handbags, wallets, purses, briefcases, suitcases, rucksacks, carry all bags and carry-on bags; umbrellas, parasols and walking sticks; whips, harnesses and saddlery

FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
GOODS AND/OR SERVICES SEC	CTION (025)(current)
INTERNATIONAL CLASS	025
DESCRIPTION	Articles of Clothing, Footwear and Headgear
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
GOODS AND/OR SERVICES SEC	CTION (025)(proposed)
INTERNATIONAL CLASS	025

#### TRACKED TEXT DESCRIPTION

Articles of Clothing, Footwear and Headgear; Clothing, footwear and headgear, namely, T-shirts, sleep wear, shirts, hats, shorts, sweat bands, sweat pants, sweat shirts, sweat shorts, sweat suits, socks and sweaters, belts, jeans, pants, skirts, underwear, jackets, coats, swimwear, shoes of leather or canvas, sneakers, slippers, boots, flip flops, caps and hats

#### FINAL DESCRIPTION

Clothing, footwear and headgear, namely, T-shirts, sleep wear, shirts, hats, shorts, sweat bands, sweat pants, sweat shirts, sweat shirts, sweat suits, socks and sweaters, belts, jeans, pants, skirts, underwear, jackets, coats, swimwear, shoes of leather or canvas, sneakers, slippers, boots, flip flops, caps and hats

FILING BASIS		Section 1(b)	
FILING BASIS		Section 44(e)	
ADDITIONAL STATEMENTS SECTION			

PRIOR REGISTRATION(S)	The applicant claims ownership of U.S. Registration Number(s) 2525322, 3378599, and 3740106.	
DISCLAIMER	No claim is made to the exclusive right to use ROYAL COUNTY OF BERKSHIRE apart from the mark as shown.	
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of the words ROYAL COUNTY OF BERKSHIRE POLO CLUB below the design of a horse with rider holding a polo mallet.	
SIGNATURE SECTION		
RESPONSE SIGNATURE	/markgkachigian/	
SIGNATORY'S NAME	Mark G. Kachigian	
SIGNATORY'S POSITION	Y'S POSITION Attorney of Record, an Oklahoma Bar member	
DATE SIGNED	10/18/2011	
AUTHORIZED SIGNATORY	YES	
FILING INFORMATION SECTION		
SUBMIT DATE	Tue Oct 18 15:35:15 EDT 2011	
TEAS STAMP	USPTO/ROA-64.207.227.18-2 0111018153515637467-85224 666-4808c2214bf86edfb847c 4a969bf526b-N/A-N/A-20111 018152342348854	

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/30/2011)

# **Response to Office Action**

# To the Commissioner for Trademarks:

Application serial no. 85224666 has been amended as follows:

#### **ARGUMENT(S)**

In response to the substantive refusal(s), please note the following:

This is in response to the Office Action e-mailed on April 24, 2011.

The Applicant gratefully acknowledges the Examining Attorney's finding that there are no similar registered or pending marks which would bar registration.

The Examining Attorney has requested clarification of the identification of goods. The Applicant appreciates the Examining Attorney's suggestion, and respectfully requests that the description of goods and services covered by the Applicant's mark be amended to read as follows:

Spectacles, spectacle cases, spectacle frames, spectacle glasses, sun glasses; and accessories therefore, namely, chains for spectacles and sunglasses, holders for spectacles and sunglasses, and lenses for spectacles and sunglasses in International Class 9; Watches, clocks, jewellery, precious stones, precious metals, goods coated with precious metals, namely, ashtrays, badges, blazer buttons, cigar and cigarette boxes, buckles for clothing, candlesticks, cosmetic powder compacts, cuff links, desktop ornaments, figurines, goblets, jewellery boxes, key chains, key rings, medals, perfume flasks, perfume sprayers, picture frames, rings, trinkets and trophies in International Class 14; Pens, pencils, writing instruments, drawing instruments, stationery, note paper, writing paper, gift wrapping paper, envelopes, greeting cards, post cards, magazines, books featuring stories and pictures, drawing rulers, tape rulers, painting sets for children; painting sets for artists, posters, calendars, diaries, photograph albums, stickers, shipping labels, printing labels, paper labels, sketch pads, paper party decorations, paper napkins, pen and pencil cases, facial tissue in International Class 16; Leather goods and imitation leather goods, namely, leather and imitation leather bags, briefcases, credit card holders, key cases, leashes for animals, cases, portfolios, purses, travelling suitcases, wallets, sports bags, straps and travelling bags; articles of luggage; athletic bags, shopping bags made of skin, beach bags, cosmetic bags sold empty, diaper bags, duffel bags, garment bags for travel, gym bags, makeup bags sold empty, overnight bags, school bags, school book bags, shoulder bags, suit bags, tote bags, travel bags and umbrella bags; trunks, holdalls, handbags, wallets, purses, briefcases, suitcases, rucksacks, carry all bags and carry-on bags; umbrellas, parasols and walking sticks; whips, harnesses and saddlery in International Class 18; and Clothing, footwear and headgear, namely, T-shirts, sleep wear, shirts, hats, shorts, sweat bands, sweat pants, sweat shirts, sweat shorts, sweat suits, socks and sweaters, belts, jeans, pants, skirts, underwear, jackets, coats, swimwear, shoes of leather or canvas, sneakers, slippers, boots, flip flops, caps and hats in International Class 25.

The Applicant believes that this amended description serves to clarify and limit, rather than expand upon, the present identification. Further, it is believed that the identification of goods is sufficiently specific to allow the Examining Attorney or third parties to reach judgment regarding possible conflicts. Lastly, it is clear, accurate and concise, as required under TMEP § 804.01.

The Examining Attorney has also requested that Applicant disclaim the wording "ROYAL COUNTY OF BERKSHIRE" apart from the mark as shown. The Applicant, in conformity with Trademark Act Section 6, 15 U.S.C. § 1056, and TMEP §§ 1213 and 1213.08(a), respectfully submits the following disclaimer of the wording "ROYAL COUNTY OF BERKSHIRE" in its application, to read as follows:

No claim is made to the exclusive right to use "ROYAL COUNTY OF BERKSHIRE" apart from the mark as shown.

Please amend the description of the mark to read:

"The mark consists of the words ROYAL COUNTY OF BERKSHIRE POLO CLUB below the design of a horse with rider holding a polo mallet."

Applicant is the owner of U.S. Trademark Registration Nos. 2,525,322; 3,378,599; and 3,740,106.

Finally, Applicant confirms that it intends to rely both on its intent-to-use in or with the United States under Section 1(b) and on the international registration under Section 44(e). A copy of the United Kingdom registrations will be provided as soon as possible.

Having addressed the concerns of the Examining Attorney, the Applicant respectfully requests that the refusal to register be withdrawn and that the mark be approved for publication in the *Official Gazette*. If any issues remain, a telephone conference with the Examining Attorney is respectfully requested.

#### CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 009 for Spectacles, Spectacle Cases, Spectacle Frames, Spectacle Glasses, Sun Glasses; and Accessories Therefore

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Filing Basis: Section 44(e), Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and /or services, and submits a copy of [United Kingdom registration number 2106096 registered 02/02/2001 with a renewal date of \_\_\_\_\_\_ and an expiration date of 07/24/2016], and translation thereof, if appropriate. 15 U.S.C. Section 1126(e), as amended.

#### Proposed:

Tracked Text Description: Spectacles, spectacle cases, spectacle frames, spectacle glasses, sun glasses; and Accessories Therefore; and accessories therefore, namely, chains for spectacles and sunglasses, holders for spectacles and sunglasses, and lenses for spectacles and sunglasses

Class 009 for Spectacles, spectacle cases, spectacle frames, spectacle glasses, sun glasses; and accessories therefore, namely, chains for spectacles and sunglasses, holders for spectacles and sunglasses, and lenses for spectacles and sunglasses

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Filing Basis: Section 44(e), Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and /or services, and will submit a copy of [United Kingdom registration number 2106096 registered 02/02/2001 with a renewal date of

and an expiration date of 07/24/2016 ], and translation thereof, if appropriate, before the application may proceed to registration. 15 U.S.C. Section 1126(e), as amended.

#### Applicant proposes to amend the following class of goods/services in the application:

Current: Class 014 for Watches, Jewellery, Precious Stones, Precious Metals, Goods Coated in Precious Metals

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Filing Basis: Section 44(e), Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and /or services, and submits a copy of [United Kingdom registration number 2278406 registered 06/14/2002 with a renewal date of \_\_\_\_\_\_ and an expiration date of 08/20/2011 ], and translation thereof, if appropriate. 15 U.S.C. Section 1126(e), as amended.

#### Proposed:

Tracked Text Description: Watches, Jewellery, Precious Stones, Precious Metals, Goods Coated in Precious Metals; Watches, clocks, jewellery, precious stones, precious metals, goods coated with precious metals, namely, ashtrays, badges, blazer buttons, cigar and cigarette boxes, buckles for clothing, candlesticks, cosmetic powder compacts, cuff links, desktop ornaments, figurines, goblets, jewellery boxes, key chains, key rings, medals, perfume flasks, perfume sprayers, picture frames, rings, trinkets and trophies

Class 014 for Watches, clocks, jewellery, precious stones, precious metals, goods coated with precious metals, namely, ashtrays, badges, blazer buttons, cigar and cigarette boxes, buckles for clothing, candlesticks, cosmetic powder compacts, cuff links, desktop ornaments, figurines, goblets, jewellery boxes, key chains, key rings, medals, perfume flasks, perfume sprayers, picture frames, rings, trinkets and trophies

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Filing Basis: Section 44(e), Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and /or services, and will submit a copy of [United Kingdom registration number 2278406 registered 06/14/2002 with a renewal date of and an expiration date of 08/20/2011], and translation thereof, if appropriate, before the application may proceed to registration. 15 U.S.C. Section 1126(e), as amended.

#### Applicant proposes to amend the following class of goods/services in the application:

Current: Class 016 for Pens, Pencils, Writing and Drawing Instruments, Stationery, Notepaper, Writing Paper, Gift Wrapping Paper, Envelopes, Greeting Cards, Post Cards, Magazines, Books, Playing Cards, Rulers, Painting Sets, Posters, Calendars, Diaries, Photograph Albums, Stickers, Labels, Sketch Pads, Paper Party Decorations, Paper Napkins, Pen and Pencil Cases, Facial Tissues Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Filing Basis: Section 44(e), Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and /or services, and submits a copy of [United Kingdom registration number 1402908 registered 08/11/1995 with a renewal date of and an expiration date of 10/25/2016 ], and translation thereof, if appropriate. 15 U.S.C. Section 1126(e), as amended.
Proposed: Tracked Text Description: Pens, Pencils, Writing and Drawing Instruments, Stationery, Notepaper,
Writing Paper, Gift Wrapping Paper, Envelopes, Greeting Cards, Post Cards, Magazines, Books, Playing
Cards, Rulers, Painting Sets, Posters, Calendars, Diaries, Photograph Albums, Stickers, Labels, Sketch
Pads, Paper Party Decorations, Paper Napkins, Pen and Pencil Cases, Facial Tissues; Pens, pencils,
writing instruments, drawing instruments, stationery, note paper, writing paper, gift wrapping paper,
envelopes, greeting cards, post cards, magazines, books featuring stories and pictures, drawing rulers, tape
rulers, painting sets for children; painting sets for artists, posters, calendars, diaries, photograph albums,
stickers, shipping labels, printing labels, paper labels, sketch pads, paper party decorations, paper napkins,
pen and pencil cases, facial tissue
Class 016 for Pens, pencils, writing instruments, drawing instruments, stationery, note paper, writing paper, gift wrapping paper, envelopes, greeting cards, post cards, magazines, books featuring stories and pictures, drawing rulers, tape rulers, painting sets for children; painting sets for artists, posters, calendars, diaries, photograph albums, stickers, shipping labels, printing labels, paper labels, sketch pads, paper party decorations, paper napkins, pen and pencil cases, facial tissue  Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).
Filing Basis: Section 44(e), Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and /or services, and will submit a copy of [United Kingdom registration number 1402908 registered 08/11/1995 with a renewal date of and an expiration date of 10/25/2016 ], and translation thereof, if appropriate, before the application may proceed to registration. 15 U.S.C. Section 1126(e), as amended.
Applicant proposes to amend the following class of goods/services in the application:  Current: Class 018 for Leather Goods; Imitation Leather Goods; Trunks, Travel Bags, Umbrellas, Parasols, Whips, Harnesses, Saddlery, Walking Sticks  Original Filing Basis:
Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

#### Proposed:

Section 1126(e), as amended.

Tracked Text Description: Leather Goods; Leather goods and imitation leather goods, namely, leather and imitation leather bags, briefcases, credit card holders, key cases, leashes for animals, cases, portfolios,

Filing Basis: Section 44(e), Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and /or services, and submits a copy

registration number registered with a renewal date of and an expiration date of ], and translation thereof, if appropriate. 15 U.S.C.

purses, travelling suitcases, wallets, sports bags, straps and travelling bags; Imitation Leather Goods; articles of luggage; Trunks, Travel Bags, Umbrellas, Parasols, Whips, Harnesses, Saddlery, Walking Sticks; athletic bags, shopping bags made of skin, beach bags, cosmetic bags sold empty, diaper bags, duffel bags, garment bags for travel, gym bags, makeup bags sold empty, overnight bags, school bags, school book bags, shoulder bags, suit bags, tote bags, travel bags and umbrella bags; trunks, holdalls, handbags, wallets, purses, briefcases, suitcases, rucksacks, carry all bags and carry-on bags; umbrellas, parasols and walking sticks; whips, harnesses and saddlery

Class 018 for Leather goods and imitation leather goods, namely, leather and imitation leather bags, briefcases, credit card holders, key cases, leashes for animals, cases, portfolios, purses, travelling suitcases, wallets, sports bags, straps and travelling bags; articles of luggage; athletic bags, shopping bags made of skin, beach bags, cosmetic bags sold empty, diaper bags, duffel bags, garment bags for travel, gym bags, makeup bags sold empty, overnight bags, school bags, school book bags, shoulder bags, suit bags, tote bags, travel bags and umbrella bags; trunks, holdalls, handbags, wallets, purses, briefcases, suitcases, rucksacks, carry all bags and carry-on bags; umbrellas, parasols and walking sticks; whips, harnesses and saddlery

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

C. C. A4(A) Board or Fourier Designations Applicant has a hone fide intention to use

	s: Section 44(e), Daseu on Foreig	, ,	
	commerce on or in connection wi		
copy of [	registration number	registered	with a renewal date of
	and an expiration date of	], and translation the	ereof, if appropriate, before the
application 1	may proceed to registration. 15 U	.S.C. Section 1126(e), as a	mended.
	proposes to amend the following		the application:
Current: C	lass 025 for Articles of Clothing,	Footwear and Headgear	
Original Fili			
Filing Basis	s: Section 1(b), Intent to Use: Th	ne applicant has a bona fide	e intention to use or use through
the applican	it's related company or licensee th	e mark in commerce on or	in connection with the identified
	or services as of the filing date of t		
Filing Basis	s: Section 44(e), Based on Foreig	gn Registration: Applican	t has a bona fide intention to use
	commerce on or in connection wi		
	registration number		
	and an expiration date of	], and translation the	ereof, if appropriate. 15 U.S.C.
	6(e), as amended.		

#### **Proposed:**

Tracked Text Description: Articles of Clothing, Footwear and Headgear; Clothing, footwear and headgear, namely, T-shirts, sleep wear, shirts, hats, shorts, sweat bands, sweat pants, sweat shirts, sweat shorts, sweat suits, socks and sweaters, belts, jeans, pants, skirts, underwear, jackets, coats, swimwear, shoes of leather or canvas, sneakers, slippers, boots, flip flops, caps and hats

Class 025 for Clothing, footwear and headgear, namely, T-shirts, sleep wear, shirts, hats, shorts, sweat bands, sweat pants, sweat shirts, sweat shorts, sweat suits, socks and sweaters, belts, jeans, pants, skirts, underwear, jackets, coats, swimwear, shoes of leather or canvas, sneakers, slippers, boots, flip flops, caps and hats

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Filing Basis	s: Section 44(e), Based on Foreig	n Registration: Applicant	has a bona fide intention to use
the mark in	commerce on or in connection wi	th the identified goods and	or services, and will submit a
copy of [	registration number	registered	with a renewal date of
	and an expiration date of	], and translation ther	eof, if appropriate, before the
application may proceed to registration. 15 U.S.C. Section 1126(e), as amended.			

#### ADDITIONAL STATEMENTS

#### Claim of Prior Registration(s)

The applicant claims ownership of U.S. Registration Number(s) 2525322, 3378599, and 3740106.

#### Disclaimer

No claim is made to the exclusive right to use ROYAL COUNTY OF BERKSHIRE apart from the mark as shown.

#### Description of mark

The mark consists of the words ROYAL COUNTY OF BERKSHIRE POLO CLUB below the design of a horse with rider holding a polo mallet.

#### SIGNATURE(S)

## Response Signature

Signature: /markgkachigian/ Date: 10/18/2011

Signatory's Name: Mark G. Kachigian

Signatory's Position: Attorney of Record, an Oklahoma Bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

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# **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Notice of Opposition was served by First Class Mail, with sufficient postage prepaid, on this 31st day of July, 2012, upon Applicant's attorney of record:

> Mark G. Kachigian, Esq. HEAD, JOHNSON & KACHIGIAN, P.C. 228 West 17<sup>th</sup> Place Tulsa, Oklahoma 74119